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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,254	09/12/2003	John Moon	CV-0043	8705

7590 08/08/2006

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50 Barnes Park North  
Wallingford, CT 06492

EXAMINER
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LAVARIAS, ARNEL C

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/661,254

Applicant(s)

MOON ET AL.

Examiner

Arnel C. Lavarias

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/19/06, 4/13/06, 3/27/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-45, 47 and 54-77 is/are rejected.
- 7) ☒ Claim(s) 46 and 48-53 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The replacement drawings were received on 3/27/06. These drawings are acceptable.

### ***Response to Amendment***

2. The amendments to the specification in the submission dated 6/19/06 are acknowledged and accepted. In view of these amendments, the objections to the drawings in Sections 3-4 of the Office Action dated 12/27/05 are respectfully withdrawn.

### ***Response to Arguments***

3. The Applicants argue that one or more terminal disclaimers would be filed to obviate the provisional double patenting rejections in Sections 12-14 of the Office Action dated 12/27/05. However, it is noted that, at present, no such terminal disclaimers have been filed or made of record in the instant application.
4. Claims 21-45, 47, 54-77 are again rejected as follows.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d

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1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 21-45, 47, 54-77 are provisionally rejected under the judicially created

doctrine of obviousness-type double patenting as being unpatentable over Claims 20-31, 40-41, 46-51, 53-69, 78-79, 84-89, 91-135 of copending Application No. 10/661031.

Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/661031 similarly recites an optical identification element having a synthesized chemical attached thereto and a method of synthesizing a chemical on a substrate, as set forth in Claims 21-45, 47, 54-77 of the instant application. It is noted that 'a chemical' (See for example Claim 20 of copending Application No. 10/661031) would encompass those chemicals that are both synthetic and naturally occurring. Further, it would have been readily apparent and obvious to one having ordinary skill in the art to perform the methods of synthesizing a chemical on a substrate based on the recited structure provided for the optical identification element.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 21-44, 47, 54-76 are provisionally rejected under the judicially created

doctrine of obviousness-type double patenting as being unpatentable over Claims 24-60,

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71-74 of copending Application No. 10/661082. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/661082 similarly recites an optical identification element having a synthesized chemical attached thereto and a method of synthesizing a chemical on a substrate, as set forth in Claims 21-44, 47, 54-76 of the instant application. Further, it is noted that 1) the recited 'item' (See for example Claim 24 of copending Application No. 10/661082) generally corresponds to the synthesized chemical as recited in the instant application, 2) it would have been readily apparent and obvious to one having ordinary skill in the art that in attaching the synthesized chemical to at least a portion of the substrate, one may view either the synthesized chemical being disposed on the substrate, or conversely the substrate being disposed on the synthesized chemical, and 3) it would have been readily apparent and obvious to one having ordinary skill in the art to perform the methods of synthesizing a chemical on a substrate based on the recited structure provided for the optical identification element.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 21-26, 28, 35, 47, 54-58, 60, 67 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 20, 26-31, 34-41, 44 of copending Application No. 10/763995. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/763995 similarly recites an optical identification element having a synthesized chemical attached thereto and a method of synthesizing a chemical

on a substrate, as set forth in Claims 21-26, 28, 35, 47, 54-58, 60, 67 of the instant application. Further, it is noted that 1) the recited solution (See for example Claim 20 of copending Application No. 10/763995) generally corresponds to the synthesized chemical as recited in the instant application, and 2) it would have been readily apparent and obvious to one having ordinary skill in the art to perform the methods of synthesizing a chemical on a substrate based on the recited structure provided for the optical identification element.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Allowable Subject Matter***

9. Claims 46, 48-53 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 571-272-2315. The examiner can normally be reached on M-F 9:30 AM - 6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



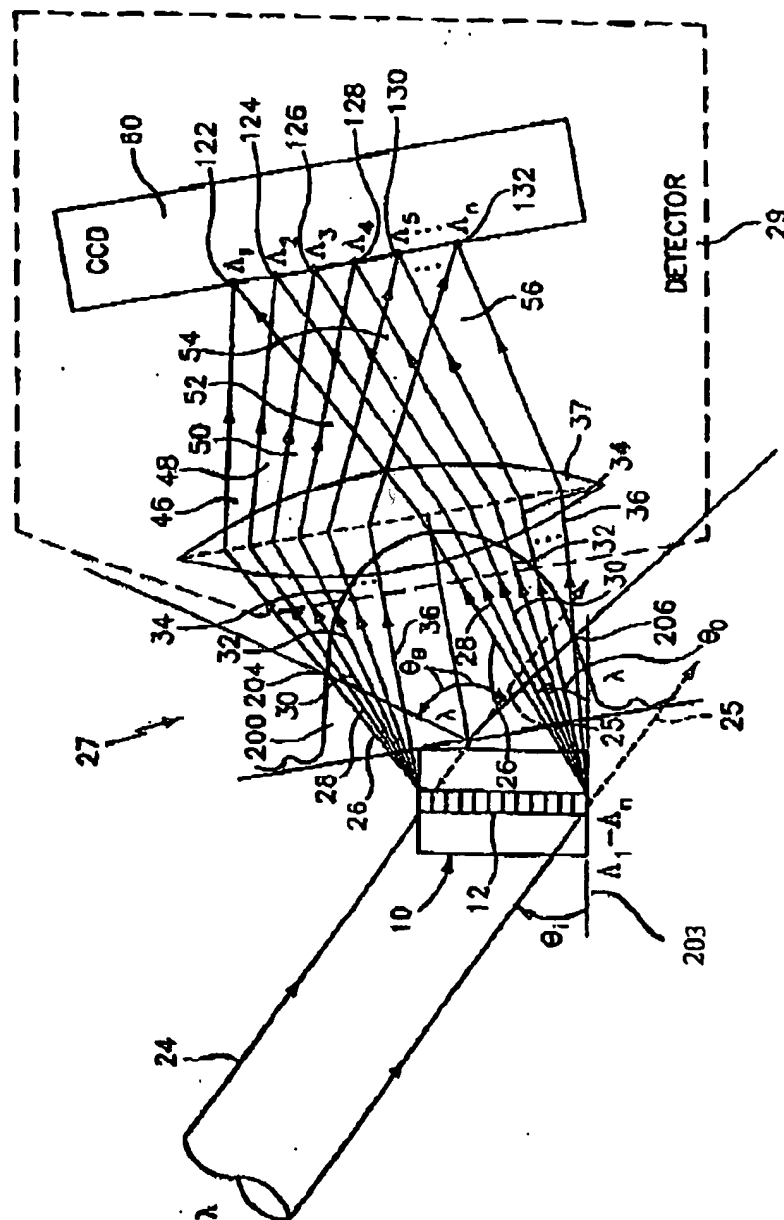
Arnel C. Lavarias  
Primary Examiner  
Group Art Unit 2872  
8/4/06



4/14

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REPLACEMENT SHEET



Drawing Changes  
Approved  
by  
8/4/06